

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF CALIFORNIA

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YELLOW CAB CO. OF SACRAMENTO,
a California Corporation,

NO. CIV. S-02-0704 FCD DAD

Plaintiff,

v.

MEMORANDUM AND ORDER

YELLOW CAB CO. OF ELK GROVE,
INC., a California
Corporation; and MICHAEL P.
STEINER, an individual,

Defendants.

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This matter is before the court on plaintiff Yellow Cab Company of Sacramento's ("plaintiff") motion in limine to exclude the expert testimony of Patrick Farrell, Ph.D.¹ Dr. Farrell, a theoretical linguist specializing in the English language, lexical semantics and grammar, is defendants Yellow Cab Company of Elk Grove and Michael Steiner's ("defendants") retained expert

¹ At the final pretrial conference, held on October 6, 2006, the court agreed to hear the instant motion on its regular law and motion calendar on December 15, 2006. Trial of this action is set to begin January 9, 2007.

1 in this trademark action² on the issue of whether the phrase
2 "yellow cab" is a generic term.

3 Plaintiff moves to exclude Dr. Farrell's testimony on
4 several, alternative grounds: (1) his testimony, based on a
5 "national market," is inadmissible pursuant to the Ninth
6 Circuit's remand order in this case; (2) his testimony does not
7 meet the requirements of Federal Rule of Evidence 702 ("Rule
8 702") and is thus inadmissible; (3) his testimony is inadmissible
9 under "Daubert" because his methodology is unreliable; and (4)
10 his testimony will prejudice the jury and is thus excludable.

11 For the following reasons, the court does not find any of
12 plaintiff's arguments availing, and therefore DENIES plaintiff's
13 motion.³

14 As to plaintiff's first argument, plaintiff mischaracterizes
15 Dr. Farrell's testimony. While he does provide testimony
16 regarding use of the term "yellow cab" in other communities,
17 including New York City, his opinions are not based solely on
18 that use in other communities. Indeed, his testimony regarding
19 New York City, to which plaintiff specifically objects, is only a
20 fractional basis of his expert report (consisting of two
21 paragraphs on page 13 of his 16-page report). To a much greater
22 extent, Dr. Farrell's opinions are based on research regarding

24 ² Plaintiff alleges claims against defendants for
25 violations of the Lanham Act, common law trademark infringement
26 and unfair competition, statutory unfair competition, false
advertising, and intentional interference with prospective
business advantage.

27 ³ Because oral argument will not be of material
assistance, the court orders this matter submitted on the briefs.
28 E.D. Cal. L.R. 78-230(h).

1 the local Sacramento community. (Expert Rpt. at 87, 88, 90-91.)
2 In its remand order, the Ninth Circuit directed this court to
3 consider in deciding the relevance of certain evidence, the
4 "territorial" or local scope of the term "yellow cab" in the
5 specific geographic area. Yellow Cab Co. of Sacramento v. Yellow
6 Cab Co. of Elk Grove, 419 F.3d 925, 930 n. 4 (9th Cir. 2005).
7 Dr. Farrell performed this analysis.

8 Moreover, Dr. Farrell's testimony is not otherwise rendered
9 inadmissible by any findings of the Ninth Circuit. In its
10 decision, the Ninth Circuit rejected defendants' "specific
11 argument . . . that the use of the term 'yellow cab' in the New
12 York City metropolitan area is dispositive in determining the
13 distinctiveness of the mark . . ." and found that "the unique New
14 York City government regulation of taxicabs is irrelevant to the
15 trademark issues presented in this case." Id. Neither of these
16 findings, however, require exclusion of Dr. Farrell's testimony.
17 First, Dr. Farrell does not opine that the circumstances in New
18 York City are dispositive of any issue in this case; rather, he
19 uses New York City's use of the phrase "yellow cab" as one
20 example supporting his ultimate opinion that "yellow cab" is a
21 generic term of the English language which is essentially
22 synonymous with taxicab. (Expert Rpt. at 98.) Second, Dr.
23 Farrell correctly states that New York City's government-
24 regulated "medallion system," requiring all taxicabs to be
25 painted yellow, does not exist in California, and he explains how
26 the term "yellow cab" is specifically used in California and the
27 Sacramento region in particular.

28 For these reasons, the Ninth Circuit's opinion does not

1 require exclusion of Dr. Farrell's testimony.

2 Regarding plaintiff's second argument, that Dr. Farrell's
3 testimony does not meet the requirements of Rule 702, the court
4 disagrees. The question of whether a mark is generic is a
5 question of fact for the jury. Id. at 419 F.2d at 929. Here,
6 Dr. Farrell offers testimony as a linguist on the issue of
7 whether "yellow cab" is a generic term in the English language.
8 Courts have routinely held in trademark actions that such expert
9 testimony provides "helpful guidance" as to how people use a
10 certain term and the "roots" of the term. Steak n Shake Co. v.
11 Burger King Corp., 323 F. Supp. 2d 983, 993 (E.D. Mo. 2004); see
12 also WSM, Inc. v. Hilton, 724 F.2d 1320, 1326 (8th Cir. 1984)
13 (upholding district court's reliance on expert testimony from
14 linguist in regional English testifying that the word "opry" was
15 a generic term); Eastern Air Lines, Inc. v. New York Air Lines,
16 Inc., 559 F. Supp. 1270, 1274 (S.D. N.Y. 1983) (finding the term
17 "air-shuttle" generic in part based on lexicography expert's
18 opinions setting forth history and present meaning of the words
19 "shuttle" and "air-shuttle").

20 Plaintiff's cases, cited to the contrary, are inapposite.
21 In Kern's Kitchen, Inc. v. Bon Appetite, 669 F. Supp. 786, 791
22 (W.D. Ky. 1987), the expert testifying was an attorney,
23 attempting to testify as to trademark law; the court excluded the
24 testimony under Rule 702 since expert testimony on the
25 controlling law does not assist the trier of fact in determining
26 a fact in issue. Id. In Thomas Pride Mills, Inc. v. Monsanto
27 Co., 155 U.S.P.Q. 205, 208 (N.D. Ga. 1967), the court did not
28 exclude the expert linguist's testimony but rather found that the

1 testimony was "insufficient in itself" to establish that
2 "Acrilan" was generic. Unlike Dr. Farrell, in Thomas Pride, the
3 expert linguist focused only on the entomology of the word. Id.

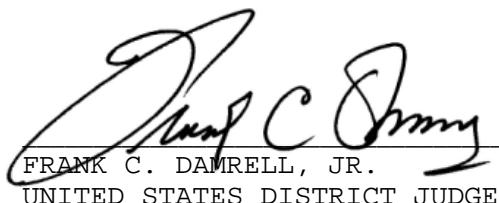
4 Next, plaintiff's third argument for exclusion of Dr.
5 Farrell's testimony is likewise unconvincing as plaintiff fails
6 to raise a proper challenge under Daubert v. Merrell Dow
7 Pharmaceuticals, Inc., 509 U.S. 579 (1993). Plaintiff proffers
8 no evidence to challenge Dr. Farrell's methodology or the
9 reliability of his opinions. Instead, plaintiff's counsel makes
10 a variety of arguments based upon *her* beliefs regarding the bases
11 for Dr. Farrell's testimony. Attorney argument is not adequate
12 to raise a Daubert issue, and thus, there is no basis for
13 exclusion of Dr. Farrell's testimony under Daubert.

14 Finally, there is also no basis for plaintiff's contention
15 that admission of Dr. Farrell's testimony will "prejudice the
16 jury." One of the jury's roles in this case is to determine,
17 from the facts and evidence presented to them, whether the
18 relevant consuming public uses the term "yellow cab" in a generic
19 sense. The jury is not, as suggested by plaintiff, to use their
20 own "general knowledge" to determine the issues in this case.

21 Dr. Farrell's testimony is admissible as it is relevant to
22 the issues presented in this case, and it could assist the jury
23 in understanding the evidence and determining the factual issues.
24 Fed. R. Evid. 702. Accordingly, plaintiff's motion in limine to
25 exclude his testimony is DENIED.

26 IT IS SO ORDERED.

27 DATED: December 11, 2006.



FRANK C. DAMRELL, JR.
UNITED STATES DISTRICT JUDGE